

REMARKS**I. STATUS OF THE CLAIMS**

Claims 20-37 are pending in this patent application. Claims 1 – 19 were previously cancelled.

Claims 25 – 27 have been amended to correct antecedent basis.

II. DOUBLE PATENTING REJECTIONS

Claims 20 – 31, 36 and 37 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over at least one of US 6,291,555 (Surjan '555), US 6,403,678 (Surjan '678), and US 6,420,458 (Surjan '458) in view of US 6,166,849 (Coleman) and US 5,681,128 (Morgan). In addition, claims 32 – 35 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over US 6,645,340 (Gienau) and US 5,962,602 (Harman).

Although not necessarily agreeing with the Office's conclusions, applicants will consider filing terminal disclaimers directed to the abovementioned patents if the claimed subject matter is otherwise allowable. Such terminal disclaimers will render these obviousness-type double patenting rejections moot.

III. INDEFINITENESS REJECTION

Claims 25 – 27 have been rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office notes that the term "amine curing agent" lacks antecedent basis. This rejection is respectfully traversed in view of the abovementioned amendments.

IV. OBVIOUSNESS REJECTIONS

Claims 20 – 31, 36, and 37 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Surjan '555, Surjan '678, Surjan '458, and US 6,402,434 (Surjan '434), and US 6,416,246 (Surjan '246), in view of Coleman and Morgan. These claims have also been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Coleman, Morgan, Gienau, Hartman, US 4,623,702 (Grieves), EP 488,949, and JP 200-273354 (Abstract). Claims 32 – 35 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the abovementioned references further in view of Gienau and Hartman. Claims 32 – 35 also have been rejected as allegedly being unpatentable over Gienau, Hartman, EP 488,949, Toussaint, Grieves, and JP 200-273354 (Abstract).

In applicant's communication dated October 2, 2007, applicants argued that the claimed invention was not obvious in view of the cited references for at least the reason that none of the references taught the claimed combination of compounds as a curing agent, namely a curing agent consisting essentially of a plurality of aliphatic amines and at least one tertiary amine. Citing MPEP 2144.06, the Office rejected the pending claims arguing that a *prima facie* case of obviousness is established where two compositions, each of which is taught by the prior art to be useful for the same purpose, are combined in order to form a third composition to be used for the very same purpose. Applicants assert that such a conclusion is neither consistent with the Supreme Court's recent holding in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) nor with MPEP 2143.

More particularly, MPEP 2143(A) states that to reject a claim based upon the premise that the invention involves a combination of prior art elements, one of ordinary skill in the art would have to recognize that the results of the combination were **predictable**. Thus, the rationale to support a conclusion that a claim would have been

obvious is that a composition formed via the combination of two or more known compounds must yield **predictable** results to one of ordinary skill in the art. If such a finding cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. Thus, a claimed invention is not obvious where prior art elements are combined according to known methods to yield **unpredictable** results.

As indicated in the specification, “applicant has found that exceptionally surprising and unexpectedly beneficial results are obtainable from adhesive compositions comprising a difunctional liquid epoxy derived from bisphenol A / epichlorohydrin and a curing agent comprising at least one aliphatic amine and at least one tertiary amine.” (Specification, p. 3) Moreover, as noted at page 8 of the Specification, highly preferred embodiments involve a curing agent having a first and second aliphatic amine. For at least the reason that the claimed curing agent composition yields unpredictable and superior results relative to curing agents of the references cited by the Office, the claimed invention is nonobvious over these references. The rejection under § 103(a) is, therefore, respectfully traversed.

Currently with this Reply, Applicants are filing a petition under 37 C.F.R. 1.103(a) to suspend action on this application in order to evaluate the potential for additional data supporting the abovementioned expected results.

V. CONCLUSION

Applicants believe that the foregoing constitutes a complete and full response to the Action of record. Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that have not been paid to Deposit Account No. 19-5425.

Respectfully submitted,

Date: 05/02/08

/Jimmie Johnson/

Jimmie Johnson
Registration No. 52,485

Synnestvedt & Lechner, LLP
1101 Market Street, Ste. 2600
Philadelphia, PA 19107
(215) 923-4466

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